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10/587,126

07/21/2006

Peter J. Dronzek Jr.

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EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,126	Applicant(s) DRONZEK JR., PETER J.	
	Examiner John L. Goff	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 3/2/10.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1, 2, 5, 6, 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta et al. (U.S. Patent 3,257,225) in view of Heise et al. (U.S. Patent 2,805,172).

Marotta discloses a method for applying a polymeric label to a substrate comprising applying a layer of primer and water remoistenable/water based glue to the label, thereafter drying the layer to form a label stock, applying a sufficient amount of water to activate the glue, and fastening the label to the substrate. Marotta teaches the polymeric label is for example a polyolefin such as polyethylene or polypropylene, and the water remoistenable glue is for example animal glue (Figure and Column 1, lines 10-18 and Column 2, lines 58-61 and Column 4, lines 9-11, 25-27, 35-46, and 57-62 and Column 5, lines 64-65). It would have been obvious to one of ordinary skill in the art to use as the polymeric label and water remoistenable glue any of the specific materials taught by Marotta including a polyethylene or polypropylene label and animal glue as Marotta does not teach away from or require any particular combination of the materials suggested.

Regarding the limitations of “a hydrophilic solid material”, “a tacky fastenable adhesive”, and “curing the polymeric label”, the material, i.e. dried animal glue, and method, i.e.

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activating the animal glue with water, taught by Marotta is consistent and in agreement with that claimed and disclosed in applicants specification as a hydrophilic solid material that forms a tacky fastenable adhesive when activated with water and cures by drying to fasten the label to the substrate such that the method taught by Marotta is considered to necessarily result in the same.

Regarding the limitation of “a glass, plastic, or metal container or surface” and “water containing a cross-linking agent or a water based adhesive containing a cross-linking agent” of claim 1 and “a aqueous dispersion comprising animal glue containing a cross-linking agent” of claim 11, Marotta is silent to applying the label to any particular substrate simply suggesting any porous or non-porous substrates. Further, Marotta does not require using any particular animal glue or water activator. It was known in the art that the animal glue include a water soluble salt, considered a cross-linking agent, in a dispersion and the water activator include glyoxal, considered a cross-linking agent, and an acid or acid salt such that the animal glue will form a water resistant bond between a label and a substrate such as a bottle as shown by Heise (Column 1, lines 15-13 and Column 3, lines 8-20 and Example II). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the animal glue and water activator taught by Marotta the specific animal glue and water activator shown by Heise to form a water resistant bond between the label and a known suitable substrate such as a glass container.

Regarding claims 1, 2, and 11, Marotta teaches about 10 parts of animal glue to about 1 part of primer such that the dried layer is considered at least 30% and also 90% by dry weight animal glue.

Regarding claim 8, water, cross-linking agent, and an acid or acid salt is considered a water based activator containing an effective amount of a cross-linking agent.

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Regarding claim 9, Marotta and Heise are silent as to the specific amount of animal glue applied, and Marotta appears to suggest as exemplary 6 to 16 lbs./3000 square feet. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine the amount of animal glue required in Marotta as modified by Heise as a function of achieving an adequate bond between the label and container wherein because the material and method taught by Marotta as modified by Heise is consistent and in agreement with that disclosed by applicant and both result in an adequate bond one of ordinary skill would readily expect to use the same in Marotta as modified by Heise as claimed. It is noted that applicants specification discloses 0.25 to 8 lbs./3000 square feet is employed (Page 24, lines 15-21), and the claimed range is 120 to 4300 lbs./3000 square feet such that it appears the claimed range may be in error. Further, the specification does not show any unexpected result for either of the ranges of amounts other than these amounts result in an adequate bond.

4. Claims 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta and Heise as applied to claims 1, 2, 5, 6, 8, 9, and 11 above, and further in view of Dronzek (U.S. Patent Application Publication 2001/0035265).

In the event the water soluble salt taught by Heise is not necessarily considered a cross-linking agent the following rejection would apply also to claim 11. Marotta and Heise teach all of the limitations in claims 10, 11, and 13 as applied above except for a specific teaching of additional additives included with the animal glue. It was known in the art of using water activated adhesive in labeling that the adhesive include a slip aid to prevent excessive friction between the adhesive and label and humectants such as urea or glycerin (also cross-linking

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agents) to impart layflat properties to the label as shown by Dronzek (Paragraphs 0045 and 0048). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the animal glue taught by Marotta as modified by Heise known additives such as a slip aid or humectants as shown by Dronzek to prevent excessive friction between the glue and the label and impart layflat properties to the label.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta and Heise as applied to claims 1, 2, 5, 6, 8, 9, and 11 above, and further in view of Leiner et al. (U.S. Patent 2,985,605).

In the event the water soluble salt taught by Heise is not necessarily considered a cross-linking agent the following rejection would apply. Heise is not limited to any particular water soluble salt and suggests alkali salts such as sodium (Column 5, lines 44-49). It was known in the art of using an animal glue with an alkali salt to use as the salt an alkali, e.g. sodium, salt of trimethylphenol, a cross-linker for the animal glue, to improve the bond strength of the glue as shown by Leiner (Column 2, lines 16-24 and 70-72 and Column 3, lines 1-3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the alkali salt in Marotta as modified by Heise the specific salt taught by Leiner to improve the bond strength of the glue.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta, Heise, and Leiner as applied to claim 11 above, and further in view of Dronzek.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the water based adhesive taught by Marotta as modified by Heise and

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Leiner a slip aid as shown by Dronzek to prevent excessive friction between the glue and the label.

7. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dronzek in view of Leiner.

Dronzek discloses a method for making a polymeric label stock comprising applying a layer of water based adhesive to a polyethylene or polypropylene label stock and thereafter drying the layer (See the abstract). Dronzek is not limited to any particular adhesives and suggests using a commercially available adhesive including natural water based adhesives such as starch or casein based (Paragraph 0041). Leiner teaches a natural water based adhesive with high bond strength and high water resistance comprising at least 30% by dry weight of animal glue applied as an aqueous dispersion comprising the animal glue and cross-linking agent (Column 1, lines 11-13 and Column 2, lines 7-32 and Column 4, lines 26-27). It would have been obvious to one of ordinary skill in the art to use as the adhesive in Dronzek the natural adhesive taught by Leiner having high bond strength and high water resistance.

Regarding the limitations of “a layer of an hydrophilic solid material”, the material, i.e. animal glue, and method, i.e. applying the animal glue and drying, taught by Dronzek as modified by Leiner is consistent and in agreement with that claimed and disclosed in applicants specification as resulting in a layer of a hydrophilic solid material such that the method taught by Dronzek as modified by Leiner is considered to intrinsically result in the same.

Regarding the limitation of “for application to a glass, plastic or metal container or surface”, this limitation is directed to the intended use of the label stock wherein the label stock

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taught by Dronzek as modified by Leiner is capable of application to a glass, plastic or metal container or surface.

Regarding claim 13, Leiner further teaches including silicates, a slip agent.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11 and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,517,664 in view of Leiner. Claims 1-29 of U.S. Patent No. 6,517,664 fully encompass claims 11 and 13 of the instant application except for a teaching of the water based adhesive comprising at least 30% by dry weight of animal glue in which it is obvious to use as the adhesive the animal glue taught by Leiner more fully described above a known suitable glue having the benefit of forming high bond strength and a water resistant bond. Regarding the limitation of “for application to a glass,

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plastic or metal container or surface”, this limitation is directed to the intended use of the label stock wherein the label stock taught by claims 1-29 of U.S. Patent No. 6,517,664 as modified by Leiner is capable of application to a glass, plastic or metal container or surface.

9. Claims 1-3, 5, 6, and 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,090,740 in view of Heise and Marotta. Claims 1-4 of U.S. Patent No. 7,090,740 fully encompass claims 1, 2, 5, 6, and 8-10 of the instant application except for a teaching of the water activatable fastening layer comprising at least 30% by dry weight of animal glue in which it is obvious to use as the adhesive the water activatable animal glue taught by Heise more fully described above a known suitable glue having the benefit of forming a water resistant bond. It would have been further obvious to one of ordinary skill in the art at the time the invention was made to use as the polymeric label that known as suitable in the art such as polyethylene or polypropylene as shown by Marotta. Claim 10 is further rejected in view of Dronzek as it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the animal glue a slip aid as shown by Dronzek to prevent excessive friction between the glue and the label.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 2, 4, 5, 8-11, and 13 have been considered but are moot in view of the new ground(s) of rejection.

In view of applicants amendment the rejections over Mallik (U.S. Patent Application Publication 2003/0102080) are withdrawn. The new limitations are fully addressed above. It is further noted both Heise and Leiner are analogous to the Dronzek patents in that each reference

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is directed to known water based adhesives having the benefit of water resistance which benefit is not a function of the specific material of the substrates bonded.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571)272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/
Primary Examiner, Art Unit 1791